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EXAMINER

LABAZE, EDWYN

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,903

Applicant(s)

BRUNNER, JAMES

Examiner

EDWYN LABAZE

Art Unit

2876

A✓

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 and 56-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 and 56-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 2/12/2004.
2. Claims 1-52, and 56-65 are presented for examination.

Drawings

3. New corrected drawings are required in this application because figs. # 5-6, 9-10, and 11-15 are not clearly readable. The applicant is respectfully requested to submit some new formal drawings so as to render the claimed invention in condition for allowance. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Allowable Subject Matter

4. The indicated allowability of claims 55-65 is withdrawn in view of the newly discovered reference(s) to Klein et al. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-7 and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein et al. (U.S. 6,558,490).

Re claims 1, 3, 34: Klein et al. discloses method for applying labels to products, which includes a web of a substrate 216 [through the dispensing reel 214 containing the substrate/label 218 as shown in fig. # 5 of Klein et al.] that moves along a first direction (also see figs. # 4 A-D; col.9, lines 30+); and a dispensing system comprising a planar area 202 that moves parallel to the first direction and below the web 216, wherein the web moves substantially independently [as indicated in figs. # 4 A-D, 5 of Klein et al.; the planar area 202 moves independently {herein disclosed as a parallel direction from the conveyor of the web} and from a different direction of the web 216] of the planar area 202 and the web 216 lies upon the planar area (see fig. # 5); and an applicator 212 that places a label 218 upon a portion of the web that lies above the planar area 202 (col.9, lines 30+), and further comprising a moving conveyor belt 202 that defines the planar area (col.9, lines 21+).

Re claims 2, 35: Klein et al. teaches an apparatus, further comprising a pressing apparatus [through nip point 21 and roller 19] that presses the label 150 onto the web 38 so as to attach the label to the portion of the web (col.7, lines 17+).

Re claim 4: Klein et al. discloses an apparatus and method, wherein the dispensing system comprises a moving conveyor belt 202 that defines the planar area (as shown in fig. # 5 of Klein et al.; col.9, lines 20+).

Re claims 5, 6, 36-38: Klein et al. teaches an apparatus and method, wherein the web 38 and the planar area 202 move at the substantially the same speed while the label 150 is being

pressed by the pressing apparatus [through the roller 19] onto the portion of the web (as shown in fig. # 4 A-D of Klein et al.; col.7, lines 10+).

Re claim 7: Klein et al. discloses an apparatus and method, wherein the pressing apparatus comprises a roller 19 that presses the label unto the portion of the web 38 (col.7, lines 18+).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (U.S. 6,558,490) in view of Pinchen et al. (U.S. 6,627,031).

The teachings of Klein et al. have been discussed above.

Klein et al. fails to teach a second roller that lies opposed to the first roller and the web and the planar area lie between the first and second rollers.

Pinchen et al. discloses tagging material method and means for applying tagging material, which includes a pressing apparatus having rollers 23 & 30 and wherein the web and the planar area [through the conveyor belt 51] lie between the first and second rollers 23, 39 (as shown in fig. # 6 of Pinchen et al.; col.10, lines 15+).

In view of Pinchen et al.'s teaching, it would have been obvious to artisan of ordinary skill in the art at the time invention was made to employ into the teachings of Klein et al. a pair of rollers as the pressing apparatus for attaching/pressing the label onto the articles. Furthermore,

such modification would provide more pressure onto the article [wherein the bottom roller serves a push up force to the first roller] so that the label is firmly attached [preventing air gap, misalignment and distortion]. Moreover, such modification would have been an obvious extension as taught by Klein et al.

9. Claims 9-15, 26-29, 39, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (U.S. 6,558,490) in view of Chamberlain et al. (U.S. 5,614,278).

The teachings of Klein et al. have been discussed above.

Klein et al. fails to disclose a security element printed on the label, wherein the security element comprises a soft magnetic material with an electro-magnetically operating circuit.

Chamberlain et al. teaches a strip of separable labels having a display surface for display of information thereon, which includes labels with security elements (col.8, lines 38+), wherein the security label includes a magnetically soft material (col.12, lines 58-60), an electro-magnetically operating oscillating circuit (col.13, lines 11-18), wherein the label includes an adhesive layer (col.6, lines 2+) which contains a first surface that adhesively engages the security element and a second element that adhesively engages a portion of the web (col.14, lines 28-49), wherein the label is attached to a second web prior to being placed on a portion of the web (col.14, lines 43-49).

In view of Chamberlain et al.'s teaching, it would have been obvious to artisan of ordinary skill in the art at the time invention was made to integrate into the teachings of Klein et al. security elements [such as soft magnetic material with an electro-magnetically operating circuit] during the manufacturing of labels to prevent and detect theft and identification of the protected articles. Furthermore, the security element is used to that it emits a characteristic

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signal, which is detected by a detecting device and evaluated as an identification signal for merchandises/articles passing the monitoring on an unauthorized manner. Security elements can be placed under the labels to excite electro-magnetically or acoustically or by radio frequencies. Moreover, such modification would have been an obvious extension as taught by Klein et al., and therefore an obvious expedient.

Re claim 15: Klein et al. discloses a peeler plate 220 that separates the second web from the label (col.9, lines 39+).

10. Claims 22-32, 40-41, 43-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (U.S. 6,558,490) as modified by Chamberlain et al. (U.S. 5,614,278) above in claim 9, and further in view of barber et al. (U.S. 4,183,779).

Re claims 22-29: The teachings of Klein et al. have been discussed above. Klein et al. fails to teach a second applicator that places a second label.

Chamberlain et al. discloses a second applicator 18 that places a second label upon the label placed on the web (as shown in fig. # 1a; col.9, lines 26+).

In view of Chamberlain et al.'s teaching, it would have been obvious to artisan of ordinary skill in the art at the time invention was made to employ into the teachings of Klein et al. a second application that places a second label onto the label placed on the web for added protection. Furthermore, such modification would provide another shield to the first label [containing the security element] protecting the electro-magnetically operated circuit. Moreover such modification would have been an obvious extension of the teaching of Klein et al.

Klein et al. as modified by Chamberlain et al. fails to teach a label comprising of indicia, alphanumeric, barcode.

Barber et al. discloses automatic indicia applying apparatus, which includes indicia (col.5, lines 21-24), alphanumeric characters (col.3, lines 29-38 and col.30, lines 17+), and barcode (col.13, lines 22-37).

In view of Barber et al.'s teaching, it would have been obvious to artisan of ordinary skill in the art at the time invention was made to employ into the teachings of Klein et al. as modified by Chamberlain et al. a label with an indicia, alphanumeric, and barcode so as to identify the product onto which the label is applied thereto. Furthermore, label with indicia, alphanumeric and barcode has been used in the field/art for product's identification, wherein the barcode contains all the information (manufacturer, date, pricing, location of the product, and the like) of said product. Moreover, such modification would have been an obvious extension of the teaching of Klein et al. as modified by Chamberlain et al., therefore an obvious expedient.

11. Claims 16-21, 30-32, 34, 42, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (U.S. 6,558,490) in view of barber et al. (U.S. 4,183,779).

The teachings of Klein et al. have been discussed above.

Klein et al. fails to disclose a label comprising of indicia, alphanumeric, barcode.

Barber et al. discloses automatic indicia applying apparatus, which includes indicia (col.5, lines 21-24), alphanumeric characters (col.3, lines 29-38 and col.30, lines 17+), and barcode (col.13, lines 22-37).

In view of Barber et al.'s teaching, it would have been obvious to artisan of ordinary skill in the art at the time invention was made to employ into the teachings of Klein et al. a label with an indicia, alphanumeric, and barcode so as to identify the product onto which the label is applied thereto. Furthermore, label with indicia, alphanumeric and barcode has been used in the

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field/art for product's identification, wherein the barcode contains all the information (manufacturer, date, pricing, location of the product, and the like) of said product. Moreover, such modification would have been an obvious extension of the teaching of Klein et al., therefore an obvious expedient.

12. Claims 56-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (U.S. 6,558,490).

Re claim 65, 56-56: Klein et al. discloses means of moving a web 38 of a substrate along a first direction (as seen in fig. # 4 A-D); placing a label onto a portion of the web (col.9, lines 30+); pressing the label onto the portion of the web (col.7, lines 17+); controlling the linear speed [through the micro-processor 78] of the web along the first direction (as shown in figs. # 2 A-B; col.9, lines 1-16) and moving the planar area 202 parallel [as indicated in figs. # 4 A-D, 5 of Klein et al.; the planar area 202 moves independently {herein disclosed as a parallel direction from the conveyor of the web} and from a different direction of the web 216] to the direction.

Klein et al. does not explicitly disclose that the means of controlling the linear the linear speed of the web is to diminish skewing.

However, since the method of the claimed invention for diminish skewing is met by the teachings of Klein et al., therefore it would have been obvious to artisan of ordinary skill in the art at the time invention was made to suggest that the method and apparatus of Klein et al. could be used for diminishing skewing during pressing of the label onto the web. Moreover, such modification would have been an obvious extension of Klein et al.'s teachings.

Re claims 58-64: the teachings of Klein et al. have been discussed above.

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The teachings of Klein et al. have been discussed above. Klein et al. fails to teach a second applicator that places a second label.

Chamberlain et al. discloses a second applicator 18 that places a second label upon the label placed on the web (as shown in fig. # 1a; col.9, lines 26+).

In view of Chamberlain et al.'s teaching, it would have been obvious to artisan of ordinary skill in the art at the time invention was made to employ into the teachings of Klein et al. a second application that places a second label onto the label placed on the web for added protection. Furthermore, such modification would provide another shield to the first label [containing the security element] protecting the electro-magnetically operated circuit. Moreover such modification would have been an obvious extension of the teaching of Klein et al.

Klein et al. as modified by Chamberlain et al. fails to teach a label comprising of indicia, alphanumeric, barcode.

Barber et al. discloses automatic indicia applying apparatus, which includes indicia (col.5, lines 21-24), alphanumeric characters (col.3, lines 29-38 and col.30, lines 17+), and barcode (col.13, lines 22-37).

In view of Barber et al.'s teaching, it would have been obvious to artisan of ordinary skill in the art at the time invention was made to employ into the teachings of Klein et al. as modified by Chamberlain et al. a label with an indicia, alphanumeric, and barcode so as to identify the product onto which the label is applied thereto. Furthermore, label with indicia, alphanumeric and barcode has been used in the field/art for product's identification, wherein the barcode contains all the information (manufacturer, date, pricing, location of the product, and the like) of

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said product. Moreover, such modification would have been an obvious extension of the teaching of Klein et al. as modified by Chamberlain et al., therefore an obvious expedient.

Response to Arguments

13. Applicant's arguments with respect to claims 1-52, and 56-65 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Allen (U.S. 5,853,530) discloses label applicator.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
May 13, 2004



THIEN M. LE
PRIMARY EXAMINER